



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/665,687

09/20/2000

Kentoku Yamasuchi

04329/2423

9847

22852

7590

07/22/2004

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP

1300 I STREET, NW  
WASHINGTON, DC 20005

EXAMINER

MILLER, BRANDON J

ART UNIT

PAPER NUMBER

2683

14

DATE MAILED: 07/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/665,687

Applicant(s)

YAMASUCHI ET AL.

Examiner

Brandon J Miller

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 12-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 12-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 2683

## DETAILED ACTION

### *Response to Amendment*

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2 and 6-7, and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jarett in view of Whinnett.

Regarding claim 1 Jarett teaches a communication terminal including; a first radio unit configured to make radio communication with a base station, over a first radio channel in accordance with a first radio communication system (see col. 5, lines 53-54 and col. 12, lines 7-10 & 45-48). Jarett teaches the base station via which the communication terminal is connectable with a first communication terminal (see col. 4, lines 5-7). Jarett teaches a second radio unit configured to make radio communication over a second radio channel (see col. 12, lines 7-10 & 45-48). Jarett teaches connecting a first radio channel and a second radio channel, such that a communication channel between a first communication terminal and a second communication terminal can be established (see col. 3, lines 64-67 and col. 4, lines 1-7). Jarett does not specifically teach a second radio unit configured to make radio communication with a second communication terminal over a second radio channel in accordance with a second radio communication system. Whinnett teaches a communication terminal that includes a second mode configured to make radio communication with a second communication terminal over a

Art Unit: 2683

second radio channel in accordance with a second radio communication network (see col. 2, lines 66-67 and col. 3, lines 1-14 & 21-35). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include a second radio unit configured to make radio communication with a second communication terminal over a second radio channel in accordance with a second radio communication system because this would allow for an improved communication terminal able to select and register with one of a number of radio communication systems.

Regarding claim 2 Jarett teaches a first communication terminal that is connected to a public network over a wired channel (see col. 5, lines 40-50).

Regarding claim 6 Jarett teaches a channel connection method for a communication terminal connectable with a first communication terminal via a base station (see col. 4, lines 5-7). Jarett teaches making radio communication with a base station, over a first radio channel in accordance with a first radio communication system (see col. 5, lines 53-54 and col. 12, lines 7-10 & 45-48). Jarett teaches establishing a communication channel between the first communication terminal and a second communication terminal by connecting a first radio channel and a second radio channel (see col. 3, lines 64-67 and col. 4, lines 1-7). Jarett does not specifically teach making a radio communication with a second communication terminal over a second radio channel in accordance with a second radio communication system. Whinnett teaches making a radio communication with a second communication terminal over a second radio channel in accordance with a second radio communication network (see col. 2, lines 66-67 and col. 3, lines 1-14 & 21-35). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include making a radio

Art Unit: 2683

communication with a second communication terminal over a second radio channel in accordance with a second radio communication system because this would allow for an improved communication terminal able to select and register with one of a number of radio communication systems.

Regarding claim 7 Jarett teaches a second communication terminal that is connected with a public network over a wired channel (see col. 2, lines 66-67, col. 3, lines 1-3 and FIG. 1).

Regarding claim 12 Jarett teaches a communication terminal including a first radio unit configured to make radio communication with a base station over a first radio channel in accordance with a first radio communication system (see col. 5, lines 53-54 and col. 12, lines 7-10 & 45-48). Jarett teaches the base station via which the communication terminal being connectable with a first communication terminal (see col. 4, lines 5-7). Jarett teaches a second radio unit configured to make radio communication over a second radio channel (see col. 12, lines 7-10 & 45-48). Jarett teaches receiving information of a predetermined type from the base station over the first radio channel; and sending the received information to the second communication terminal over the second radio channel (see col. 3, lines 64-67 and col. 4, lines 1-11). Jarett does not specifically teach a second radio unit configured to make radio communication with a second communication terminal over a second radio channel in accordance with a second radio communication system. Whinnett teaches a communication terminal that includes a second mode configured to make radio communication with a second communication terminal over a second radio channel in accordance with a second radio communication network (see col. 2, lines 66-67 and col. 3, lines 1-14 & 21-35). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the

Art Unit: 2683

device adapt to include a second radio unit configured to make radio communication with a second communication terminal over a second radio channel in accordance with a second radio communication system because this would allow for an improved communication terminal able to select and register with one of a number of radio communication systems.

Regarding claim 13 Whinnett teaches a second communication terminal that is connected with a public network over a wired channel (see col. 2, lines 66-67, col. 3, lines 1-3 and FIG. 1).

Claims 3, 8-9, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jarett in view of Whinnett and Rouge.

Regarding claim 3 Jarett and Whinnett teach a device as recited in claim 1 except for a communication terminal including means for obtaining a telephone number of the first communication terminal via the base station when the first communication terminal is connected with the base station wherein connecting means transfers the obtained telephone number to the second communication terminal over the second radio channel. Jarett does teach obtaining a telephone number via a base station when a communication terminal is connected with the base station (see col. 54, lines 55-58). Rouge teaches obtaining a telephone number of a communication terminal wherein connecting means transfers the obtained telephone number to another communication terminal (see col. 4, lines 35-38 & 43-52). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include a communication terminal including means for obtaining a telephone number of the first communication terminal via the base station when the first communication terminal is connected with the base station wherein connecting means transfers the obtained telephone number to the

Art Unit: 2683

second communication terminal over the second radio channel because this would allow for an efficient call connection between two mobile terminals.

Regarding claim 8 Jarett, Whinnett, and Rouge teach a device as recited in claim 3 and is rejected given the same reasoning as above.

Regarding claim 9 Jarett, Whinnett, and Rouge teach a device as recited in claim 8 except for making a call to the first communication terminal from the second communication terminal in accordance with the transferred telephone number. Rouge does teach making a call to a communication terminal from another communication terminal in accordance with a transferred telephone number (see col. 4, lines 35-38 & 43-52). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include making a call to the first communication terminal from the second communication terminal in accordance with the transferred telephone number because this would allow for efficient call connection between two mobile terminals.

Regarding claim 14 Jarett and Whinnett teach a device as recited in claim 12 except for obtaining a telephone number of a calling party via a base station when the radio channel is connected to the base station, wherein the sending means transfers the obtained telephone number to the second communication terminal over the second radio channel. Jarett does teach obtaining a telephone number via a base station when a communication terminal is connected with the base station (see col. 54, lines 55-58). Rouge teaches obtaining a telephone number of a communication terminal wherein connecting means transfers the obtained telephone number to another communication terminal (see col. 4, lines 35-38 & 43-52). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to

Art Unit: 2683

include a communication terminal including means for obtaining a telephone number of a calling party via a base station when the radio channel is connected to the base station, wherein the sending means transfers the obtained telephone number to the second communication terminal over the second radio channel because this would allow for improved communication connections between two uncoordinated networks

Claims 4-5 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jarett in view of Whinnett and Grubeck.

Regarding claim 4 Jarett and Whinnett teach a device as recited in claim 1 except for a communication terminal with a transmission power of a first radio unit that is set to be sufficiently small compared to that of a second radio unit. Grubeck further teaches a communication terminal with a transmission power of a radio unit that is set to be sufficiently small compared to that of another radio unit (see col. 3, lines 13-15 and col. 5, lines 38-42). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the invention adapt to include a communication terminal with a transmission power of a first radio unit that is set to be sufficiently small compared to that of a second radio unit because this would allow for reduced interference in a radio communication system.

Regarding claim 5 a device as recited in claim 4 is taught above except for a communication terminal with a transmission power of a second radio unit that is 1/10 or less of the transmission power of a first radio unit. Grubeck further teaches a transmission power of a radio unit that is 1/5 or less of the transmission power of another radio unit (see col. 5, lines 38-42). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the invention adapt to include a communication terminal with a transmission



Art Unit: 2683

power of a second radio unit that is  $1/10$  or less of the transmission power of a first radio unit because this would allow for reduced interference in a radio communication system.

Regarding claim 15 Jarett and Whinnett teach a device as recited in claim 12 except for a communication terminal with a transmission power of a first radio unit that is set to be sufficiently small compared to that of a second radio unit. Grubeck further teaches a communication terminal with a transmission power of a radio unit that is set to be sufficiently small compared to that of another radio unit (see col. 3, lines 13-15 and col. 5, lines 38-42). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the invention adapt to include a communication terminal with a transmission power of a first radio unit that is set to be sufficiently small compared to that of a second radio unit because this would allow for reduced interference in a radio communication system.

Regarding claim 16 a device as recited in claim 15 is taught above except for a communication terminal with a transmission power of a second radio unit that is  $1/10$  or less of the transmission power of a first radio unit. Grubeck further teaches a transmission power of a radio unit that is  $1/5$  or less of the transmission power of another radio unit (see col. 5, lines 38-42). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the invention adapt to include a communication terminal with a transmission power of a second radio unit that is  $1/10$  or less of the transmission power of a first radio unit because this would allow for reduced interference in a radio communication system.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-9 and 12-16 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 2683

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ito U.S. Patent 5,297,190 discloses a radio communication system.

Tokuyoshi U.S. Patent 6,377,806 discloses a mobile phone with communication channel switching determination unit.

Scott, II U.S. Patent 6,282,423 discloses a wireless communication system with selectable signal routing and method therefor.

Grau U.S. Patent 5,200,951 discloses an apparatus and method for transmitting messages between a plurality of subscriber stations.

Art Unit: 2683

Eisdorfer U.S. Patent 5,960,348 discloses a technique for use in processing telephone calls.

Evanyk U.S. Patent 5,930,728 discloses an up converted home base station.

Bowater et al. U.S. Patent 5,970,126 discloses a communication method and system.

Lester et al. U.S. Patent 6,745,043 discloses a priority communication system and method of operation.

Chiba EP 1 089 448 A2 discloses a mobile communication apparatus.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon J Miller whose telephone number is 703-305-4222. The examiner can normally be reached on Mon.-Fri. 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

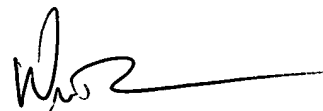
\*\*\*

Application/Control Number: 09/665,687

Page 11

Art Unit: 2683

July 14, 2004



WILLIAM TROST  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600